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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,902	10/06/2000	Joaquin Feria	10022/46	2958

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ACCENTURE CHICAGO 28164
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

EXAMINER

STIMPAK, JOHNNA

ART UNIT PAPER NUMBER

3623

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,902

Applicant(s)

FERIA ET AL.

Examiner

Johnna R Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a non-final office action upon examination of application number 09/680,902. Claims 1-13 and 16-22 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments with respect to claims 1-13 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 16 is objected to because of the following informalities: Claim 16 is dependent on claim 14, which has been canceled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 4, 5 and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by TCO Analyst from Gartner Consulting.

As per **claim 1**, TCO Analyst teaches obtaining base costs (page 8, fig 5 – costs for each category listed in figure 5 are used in the tco calculation, these include capital costs (base costs);

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obtaining ongoing direct costs (page 9, fig 6 teaches direct costs); obtaining ongoing indirect costs (page 9, fig 6 teaches indirect costs); gathering information relating to user profiles and organizational characteristics (page 8, fig. 5 shows the organizational categories for which information is gathered); inputting the costs and information into a computer program to determine the cost for each user and a plurality of appraisal metrics (page 17-19, cost is the primary metric for the tco calculation, but also included are metrics associated with risk such as risk of implementation; also operational risk which includes performance/downtime, data loss/corruption, etc.); wherein the appraisal metrics include financial perspectives and non-financial perspectives (page 17-19, cost is the primary metric for the tco calculation, but also included are non-financial metrics associated with risk such as risk of implementation; also operational risk which includes performance/downtime, data loss/corruption, etc.); assigning each of the appraisal metrics to correspond to an information technology organization function category, wherein the organizational function category comprises service management (page 8, figure 5, administration category includes purchasing and auditing); systems management (page 8, figure 5, capital category includes software and hardware); service planning (page 8, figure 5, technical support category includes training) and change management (page 8, figure 5, subcategories include purchasing and installation, adds, moves and changes)(page 10, section 3.4.1 – management complexity influenced by change management, planning, etc.); selecting an information technology organization function category (page 21 – users can customize their tco estimates); and reporting both the financial and non-financial appraisal metrics corresponding only to the selected category (page 21 – the customization of the tco estimates inherently would

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include reporting of both financial and non-financial appraisal metrics if those metrics were chosen by the user during customization of the estimate).

As per **claim 4**, TCO Analyst teaches the ongoing indirect costs include end-user costs and downtime costs (page 9, fig 6 – end user costs and downtime costs are included).

As per **claim 5**, TCO Analyst teaches at least one of the costs correspond to at least one information technology function, and the cost for each user is broken down according to the information technology function (page 8, fig 5 shows categories corresponding to several functions of an information system, these categories are broken down into subcategories to distinguish between budgeted and unbudgeted costs).

As per **claim 17**, TCO Analyst teaches the appraisal metrics include financial perspective metrics (page 17 – cost is primary metric), operational effectiveness and efficiency metrics (page 19 teaches operational risk as a metric), and infrastructure and evolution perspective metrics (page 18 teaches implementation risk as a metric).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 3, 6-16 and 18-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over TCO Analyst, from Gartner Consulting.

As per **claim 2**, TCO Analyst teaches capital costs (page 8, fig. 5), but does not expressly teach the base costs include design costs, acquisition costs, and installation costs, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 3**, TCO Analyst teaches the ongoing direct costs (page 9, figure 6), but does not expressly teach the ongoing direct costs include production control costs, monitoring costs, security management and failure control costs, changes in upgrade costs, support costs, and operational costs. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 6**, TCO Analyst teaches obtaining cost information (page 8, fig 5 – costs for each category listed in figure 5 are used in the tco calculation); obtaining system characteristics (page 8 – system characteristics are gathered according to software and hardware; page 11 – IT

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infrastructure complexity is determined based on system characteristics for the tco estimate); calculating appraisal metrics based on the cost information and the system characteristics ((page 17-19, cost is the primary metric for the tco calculation, but also included are non-financial metrics associated with risk such as risk of implementation; also operational risk which includes performance/downtime, data loss/corruption, etc.); assigning each of the appraisal metrics and the cost information to correspond to an information technology organizational function category, wherein the organizational function category comprises service (page 8, figure 5, administration category includes purchasing and auditing); systems management (page 8, figure 5, capital category includes software and hardware); service planning (page 8, figure 5, technical support category includes training) and change management (page 8, figure 5, subcategories include purchasing and installation, adds, moves and changes)(page 10, section 3.4.1 – management complexity influenced by change management, planning, etc.); comparing the appraisal metrics with established benchmarks (page 16 – calculations are compared to benchmarks (a sliding scale of best practices). TCO analyst does not explicitly teach reporting the appraisal metrics and cost information in separate reports for the corresponding organizational function categories. However in the art of reporting data it is well known to customize reports based on information that is important to the user. TCO Analyst teaches customizing tco estimates and thereby it would have been obvious to one of ordinary skill that this customization of the calculation would also include a custom report based on the information that was deemed to be pertinent at the time. The customization of the report makes the system more user friendly as the data is more easily read and combed through in a customized report.

As per **claim 7**, TCO Analyst teaches the cost information includes base costs, ongoing direct costs and ongoing indirect costs (page 8, fig 5 – costs for each category listed in figure 5 are used in the tco calculation, these include capital costs (base costs); (page 9, fig 6 teaches direct costs); (page 9, fig 6 teaches indirect costs)

As per **claim 8**, TCO Analyst teaches capital costs (page 8, fig. 5), but does not expressly teach the base costs include design costs, acquisition costs, and installation costs, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 9**, TCO Analyst teaches the ongoing direct costs (page 9, figure 6), but does not expressly teach the ongoing direct costs include production control costs, monitoring costs, security management and failure control costs, changes in upgrade costs, support costs, and operational costs. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

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patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per **claim 10**, TCO Analyst teaches the ongoing indirect costs include end-user costs and downtime costs (page 9, fig 6 – end user costs and downtime costs are included).

As per **claim 11**, TCO Analyst teaches the system characteristics include financial characteristics, operational and efficiency characteristics, and infrastructure and evolution characteristics (page 8, fig 5 shows financial characteristics for each category; operational risk categories include operational and efficiency characteristics, page 18 teaches implementation characteristics).

As per **claim 12**, TCO Analyst teaches the appraisal metrics include financial perspective metrics (page 17 – cost is primary metric), operational effectiveness and efficiency metrics (page 19 teaches operational risk as a metric), and infrastructure and evolution perspective metrics (page 18 teaches implementation risk as a metric).

As per **claim 13**, TCO Analyst teaches the financial perspective metrics are based on the financial characteristics and the cost information (page 17, cost is the primary metric which includes direct and indirect costs).

As per **claim 16**, TCO Analyst teaches the metrics are used to determine cost improvement opportunities through best practices implementation for the category (page 16 – a sliding scale of best practices are implemented to achieve optimum benefit).

As per **claims 18-22**, the claim limitations constitute non-functional descriptive material and are not functionally used nor do they alter the recited structural elements. The recited method would be performed the same regardless of the specific data. Thus, this descriptive

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material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Burns, Louis. J. "Adding value, not cost"

Hudgins-Bonafield, Christy. "The message about TCO"

"New GartnerGroup Report from Gartner Direct Aims to Reduct IT Total Cost of Ownership"

"Ten ways to save millions"


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R Stimpak whose telephone number is 703-305-4566. The examiner can normally be reached on M-F 8am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS
1/10/05



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600